

Analysis Results of US-JP Collaborative Search Pilot Program Phase 1

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ADMINISTRATIVE AFFAIRS DIVISION

The benefits of using US-JP Collaborative Search Pilot Program includes:

- 1) Improving the predictability of the information on the timing of examinations and acquisition of patent rights for applicants due to the earlier and simultaneous dispatch of initial examination results from both Offices (Applicants are not required to pay additional fee at both Offices)
- 2) Sharing of the examiners' opinions enables to increase the possibility for applicants to receive the same examination results from both Offices and to decrease the burden for applicants to respond to FA provided by both Offices. As a result, applicants are more likely to acquire stronger and more stable patent rights.
- 3) Reducing the burden for applicants to submit Information Disclosure Statement (IDS) to USPTO for the documents presented by JPO examiners in the initial examination results (Cited Documents and Prior Art documents)
- 4) If a group of technically-related applications were filed with the JPO, the examiners of the two Offices shall send the initial examination results to an applicant in the same time period, allowing the applicant to receive the examination results of those applications during the same time period.

As shown below, JPO was able to confirm the results supporting the above-mentioned benefits (especially 1 and 2) with the Analysis Results of US-JP Collaborative Search Pilot Program Phase 1 (from August 1, 2015 to July 30, 2017)

1. Details of Requests

The distribution of technical fields of the accepted requests for the phase 1 of US-JP CSP is as follows.

Office of First Search (OFS)	The Japan Patent Office (JPO)	The United States Patent and Trademark Office (USPTO)
Number of Requests	37	27

IPC Section	A	B	C	D	E	F	G	H
Number of Requests	7	3	13	0	0	0	31	8

2. Analysis of Determinations by both Offices

The analysis results regarding the determinations of both Offices with the phase 1 of US-JP CSP are as shown in the table below.

In addition to the determinations on Novelty and Inventive Step, Patent Eligibility (35 U.S.C. 101), Eligibility for Patent (Japan Patent Act Article 29 Section 1 Main Paragraph) and Means Plus Function (MPF) claims which can affect the interpretation of claims have been analyzed.

The analysis below is targeted for the initial examination results (FA¹) in US-JP CSP.

	Number of Matched Determinations	Number of Mismatched Determinations
Novelty / Inventive Step ²	51	13
Patent Eligibility / Patentability	50	14
MPF claims ³	-	9

Matched and Mismatched determinations between both Offices

Especially, in the analysis of the determinations on Novelty and Inventive Step, about 80% (51 out of 64) of the determinations from both Offices have matched.

As for the cases where mismatched determination were found, there were the cases where the mismatched determinations seem to be derived from the differences in specifying cited inventions. As described below, there were also the cases where the mismatched determinations seem to be derived from the differences in determining Patent Eligibility or in the interpretation of MPF claims.

Other than the differences in the decision of Novelty and Inventive Step, as for the Computer/Software related inventions, there were 14 cases where the determination of USPTO is that the claimed inventions are only abstract ideas and do not satisfy the patent eligibility (35 U.S.C. 101), on the other hand, the determination of JPO is that they satisfy the Eligibility for Patent (Japanese Patent Act Article 29 Section 1 Main Paragraph).

In addition, at the USPTO, there were nine cases that have been determined as means-plus-function (MPF) claims and the applicants were notified of violation of Clarity.

In terms of other description requirements, there were no significant difference in the

¹ As for the phase 1 at the USPTO, “Pre-Interview Communication (PIC)” in First Action Interview System was used as the initial examination results(FA), instead of usual office action

² Even if there are multiple Reasons for Refusal with respect to the subject claims, if one Office decides that there are Reasons for Refusal due to the lack of Novelty or Inventive Step, and the other Office decides that there is no Reason for Refusal, decision by both Offices is considered to be mismatched (Other cases are considered to be matched).

³ See US Patent law Article 112 (f). The details on MPF claims are omitted here. As there is no interpretation specific to MPF claims in Japan, if the USPTO notifies MRF claim related Reasons for Refusal to applicants according to US Patent Law Article 112, those cases are considered to be “mismatched”.

determinations between the two Offices.

From the results mentioned above, though determinations may differ due to the differences in examination practice between the USPTO and the JPO, such as in the field of computer software related inventions, it can be said that the determinations by both Offices can be matched in many cases when each Office's examination results are cross-referenced by the examiners of both Offices.

3. Examination Period

The period from the acceptance of requests to the dispatch of FA is summarized as follows.⁴

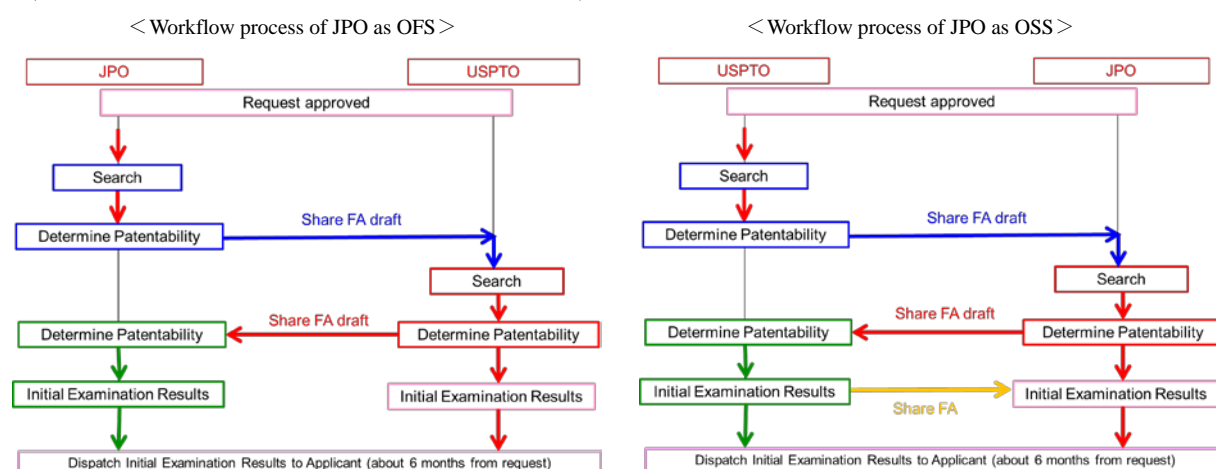
	At the JPO: from Acceptance of Request to Dispatch of FA	At the USPTO: from Acceptance of Request to Dispatch of FA
Number of days necessary	169	133

The table shows that FA is dispatched to the applicants from both Offices within 6 months from the date of acceptance of requests and the time lag of FA dispatching between JPO and USPTO is about 40 days. Therefore, it can be said that FA is dispatched to the applicants from both Offices earlier and simultaneously.

In the phase 1, Office of First Search (OFS) tends to delay the dispatch of FA more than Office of Second Search (OSS) as the OFS reconsiders the FA drafts submitted by OSS.

Further, in any case, JPO's dispatch of FA has been delayed as JPO has been dispatching FA after considering the FA submitted by USPTO, even though JPO is the OSS.

(Reference: Scheme of US-JP CSP Phase 1)



⁴ In the table, the time lag to dispatch FA does not match the difference between the left two cells as the timing of acceptance of requests may differ between JPO and USPTO.

4. User Feedback

The user feedback on the benefits using US-JP CSP is as follows.

- The concordance rate of the determinations on Novelty and Inventive Step between JPO and USPTO is high.
- There are benefits of reducing the costs with the following points:
 - 1) If the examination results of the two Offices are received at the same time period having the same results, related office procedures will also be the same at both Offices allowing applicants to complete the required procedures at one time.
 - 2) No need to submit IDS to USPTO for Prior Art documents presented by JPO
 - 3) Can receive examination results earlier free of charge without using US TRACK ONE system
- Once patent rights are set in the United States, it costs a lot of money to invalidate them, so it is grateful that examiners at both Offices can make more precise determinations by sharing examination results through US-JP CSP
- I feel that I was able to obtain stronger and more stable rights as cross-referencing of the presented documents by the examiners of both Offices can lead to the prevention of the omission in searches in the examination process.

5. IDS

Regarding the reduction of the IDS burden mentioned in (3) of page 1, the USPTO examiners should describe the documents (Cited Documents and Prior Art documents) presented by the JPO in the initial examination results in PTO-892 which is a notification form of Cited Documents and it is clearly stated on the USPTO website⁵.

It is expected that phase 2 of US-JP CSP is also going to show similar positive effects as phase 1. JPO recommends this program for the applicants who are acquiring patent rights in Japan and the United States.